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EXAMINER

MAURO JR, THOMAS J

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/699,863

Applicant(s)

HEISKA, JUKKA

Examiner

Thomas J. Mauro Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the amendment filed on May 24, 2004. Claims 1-7 have been cancelled. Claim 15 has been newly added.
2. Claims 8-15 are pending and are presented for examination. A formal action on the merits of claims 8-15 follows.
3. Objection made against the specification has been withdrawn in light of the amendment providing appropriate corrections.
4. Objection made against the drawings will be sustained until figures are formally added, such as the graphic proposed in the amendment showing the system of the present invention.

### ***Claim Objections***

5. Claim 12 is objected to because of the following informalities:
  - Claim 12 recites that it is dependent upon the "apparatus of claim 12." A claim cannot depend from itself. For purposes of examination, it is assumed this misprint refers back to the apparatus of claim 8. Appropriate correction is required.

***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a) because they fail to specifically show the structural elements of the system as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 8-15 are rejected under 35 U.S.C. 102(a) as being anticipated by Carlino et al. (WO 00/39666).

With respect to claim 8, Carlino teaches an apparatus for providing data services to mobile devices in a system comprising a data network, at least one content server accessible via the data network, at least one gateway for accessing the data network, a mobile telephone network for communicating between the mobile devices and said at least one gateway, and a

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content converter separate from the at least one gateway, separate from the at least one content server, and connected to the data network **[Carlino -- Figure 1, Abstract and Page 14 lines 19-23 - Discloses original document in World Wide Web (WWW) (20), implicitly residing on a content server, i.e. computer, server, etc., wireless gateway (14), mobile telephone (12) and content converter (16), separate, i.e. not integral, from the gateway], the apparatus comprising:**

a data store associated with the content converter for storing indications of the characteristics of each terminal **[Carlino -- Page 33 lines 10-19 – Database 18 contains wireless device preferences, i.e. characteristics, which are specific to the particular wireless device, i.e. type of display, i.e. number of viewable lines on screen. In order for the preferences to exist in the database 18, it is required that they were uploaded to content converter and its associated database];**

receiving means at the content converter for receiving content for a particular mobile terminal from said at least one content server **[Carlino -- Figure 1 and page 18 lines 19-23 – Original document from WWW is received at content converter from its source, i.e. content server];**

logic for adjusting content for the particular mobile terminal in the content converter according to the stored characteristics of the mobile terminal **[Carlino -- Page 9 lines 1-7 – Content converter converts original document, i.e. web page, etc., from one markup language to another markup language, in addition to, following the preferences stored in the database]; and**

sending means for routing the adjusted content through the data network to said at least one gateway for forwarding to said particular mobile terminal **[Carlino -- Figure 1 and Page 33 lines 19-23 – Wireless gateway (14), shown in figure 1, both receives requests and sends converted document to mobile device, i.e. mobile phone].**

With respect to claim 9, Carlino further teaches wherein the content is in wireless application protocol (WAP) format **[Carlino -- Page 33 lines 1-5 – Document is in WAP format using WML].**

With respect to claim 10, Carlino further teaches wherein the data network is a wide-area network (WAN) **[Carlino -- Figure 1 – World Wide Web or Internet is used to retrieve documents from other servers, computers etc... The Internet is classified as a WAN].**

With respect to claim 11, Carlino further teaches wherein the WAN is the Internet **[Carlino -- Figure 1 and Page 14 lines 13-16 – World Wide Web on the Internet].**

With respect to claim 12, Carlino further teaches wherein the data store further stores indications of preferences of the user of each terminal device, and wherein the logic adjusts content in accordance with stored preferences of the user **[Carlino -- Page 9 lines 1-7 and page 45 lines 3-13 – Database stores uploaded characteristics of devices and preferences of the user of the device which is used by the content converter to render documents in a manner viewable on a particular wireless device].**

With respect to claim 13, Carlino further teaches wherein the logic adjusts content in accordance with a preference currently entered by the user and stored [**Carlino -- Page 9 lines 1-7 – Content converter uses preferences and characteristics of users stored in database to adjust the original document, i.e. convert it to format suitable for wireless device. The user can make these preferences at any time and store them in the database**].

With respect to claim 14, Carlino further teaches wherein the logic adjusts content in accordance with a preference previously stored and currently selected by the user [**Carlino -- Page 9 lines 1-7 and page 45 lines 3-13 – Content converter adjusts content to that of user preferences previously stored, i.e. user stores preferences for baseball scores to render them on wireless device, in a given manner**].

With respect to claim 15, Carlino teaches a system for converting a mark-up language file into a format for presentation on a mobile terminal comprising:

a content server connected to a wide area network (WAN) for transmitting a mark-up language file over said WAN [**Carlino -- Figures 1, Abstract, page 13 lines 5-6 and page 14 lines 5-18 – Original documents, i.e. web pages in HTML, are accessed over the Internet, i.e. WAN, which implicitly reside on a server, i.e. content server**];

a content converted connected to said WAN for receiving the mark-up language file over said WAN from the content server, for converting said mark-up language file into a format appropriate for a mobile terminal, and for transmitting the converted mark-up language file over

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the WAN [Carlino -- Figure 1, Page 9 lines 1-7, page 18 lines 19-23 and page 33 lines 19-23 – **Original document from WWW is received at converter from its source, i.e. content server, upon which, it the content converter converts the original document, i.e. web page, etc., from one markup language to another markup language by following the preferences stored in the database. Upon completion, wireless gateway transmits the file over the network to the mobile device**]; and

a gateway between the WAN and a mobile telephone network for receiving the converted mark-up language file from the content converter and for transmitting the converted mark-up language file over the mobile telephone network to the mobile terminal [Carlino -- Figure 1 and Page 33 lines 19-23 – **Wireless gateway (14), shown in figure 1, both receives requests and sends converted document to mobile device, i.e. mobile phone**];

wherein said content converter is separate and distinct from said content server and from said gateway [Carlino -- Figure 1, page 14 lines 19-23 and page 15 lines 6-10 – **Content converter is not integral to the wireless gateway nor the content provider but rather is an individual component, i.e. distinct from server and gateway**]; and

wherein said content converter accesses a database storing the characteristics of the mobile terminal in order to convert the mark-up language file into a format appropriate for the mobile terminal [Carlino -- Page 33 lines 10-19 – **Database 18 contains wireless device preferences, i.e. characteristics, which are specific to the particular wireless device, i.e. type of display, i.e. number of viewable lines on screen. Converter accesses database to obtain converting information to process the conversion**].



***Response to Arguments***

9. Applicant's arguments filed May 24, 2004 have been fully considered but they are not persuasive.

(A) Applicant contends that the content converter of Carlino is integrated within the WAP gateway, whereas claim 8 and similarly claim 15 calls for the converter to be separate from the gateway and content server.

In response to argument A, Examiner demurs to this contention as Carlino distinctly points out in Figure 1 and on page 14 lines 19-23 that "Figure 1 illustrates the content converter application 16 as an individual component," and further states "the content converter 16 can ALSO be integral to the wireless gateway 14 (not illustrated in figure 1)." This quotation explicitly shows that the converter is ***not integral*** to the wireless gateway, although as Carlino points out, it can be. Therefore, the Examiner accordingly demurs to this assertion that the content converter of Carlino is integral to the gateway as Carlino explicitly states it is not, as shown in Figure 1.

Even if, *assuming arguendo*, that Carlino does not explicitly teach that the converter is separate from the gateway, it would have been obvious to a person of ordinary skill

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in the art to relocate such a subsystem, i.e. content converter to another server or proxy. As was upheld in *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), the mere rearrangement of parts does not by itself provide patentable substance unless an unexpected result is achieved. In this case, no such result is achieved and the movement of the converter system from one server to another would have been obvious.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mogul (U.S. 6,704,798) discloses a content conversion system which utilizes a proxy server separate from the content servers and client gateways for performing the conversions.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 703-605-1234. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TJM

September 8, 2004

  
JACK B. HARVEY  
SUPERVISORY PATENT EXAMINER